

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN T. COUNCIL,
ROBERT GOSS and DOV SHAKED

Appeal No. 1998-1306
Application 08/429,326

ON BRIEF

Before GARRIS, LIEBERMAN and DELMENDO, ***Administrative Patent Judges.***
GARRIS, ***Administrative Patent Judge.***

DECISION ON APPEAL

Appeal No. 1998-1306
Application 08/429,326

This is a decision on an appeal from the final rejection of claims 1-20, which are all of the claims in the application.

The subject matter on appeal relates to a composition suitable for purification of an edible oil comprising a mixture of particulate clay and a particulate polycarboxylic organic acid wherein the clay has a free moisture content of no more than about 8 percent by weight. The appealed subject matter also relates to an article of manufacture comprising a composition of the type previously described in a package provided with a vapor barrier. Finally, this subject matter additionally relates to a method of sorptive purification of edible oils prior to bleaching which comprises contacting the oil with a composition of the type described earlier. This subject matter is adequately represented by independent claim 1, which reads as follows:

1. A composition suitable for purification of an edible oil and comprising a mixture of particulate clay and a particulate, polycarboxylic organic acid having a pK_a value in the range of about 1 to about 7 and being substantially free from organic acid salts; said clay having a free moisture content of no more than about 8 percent by weight, based on the weight of the clay, and said polycarboxylic organic acid being present in an amount in the range of about 1 to about 8 percent by weight, based on the weight of the composition.

Appeal No. 1998-1306
Application 08/429,326

The references set forth below are relied upon by the examiner as evidence of obviousness:

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| Audeh et al. (Audeh) | 4,120,782 | Oct. 17, 1978 |
| Brooks et al. (Brooks) | 5,151,211 | Sept. 29, 1992 |

Claims 1-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brooks in view of Audeh.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above-noted rejection.

OPINION

We cannot sustain this rejection. Our reasons are set forth below.

Concerning the composition claims on appeal, the appellants argue that the applied references contain no teaching or suggestion of clay having a free moisture content within the range defined by independent claim 1. In response, the examiner urges "nothing has been shown that there is a difference in the products or that it makes for a patentably distinct product" (answer, page 4). We discern no merit in the examiner's apparent belief that the here-

Appeal No. 1998-1306
Application 08/429,326

claimed free moisture content of the clay in the appealed claim 1 composition does not distinguish over the clay in the composition of Brooks.

On the one hand, the examiner points to no teaching (and we find none independently) in the Brooks patent concerning the free moisture content of patentee's clay. On the other hand, the appellants' specification discloses the deliberate step of drying their clay in order to obtain a particular free moisture level (see specification, page 10, lines 28-35) in order to preserve optimum effectiveness and shelf life of their composition (see specification, page 9, lines 20-29). Thus, the record before us contains nothing to support the examiner's proposition that the respective clays used in the here-claimed composition and in the composition of Brooks contain the same free moisture content. However, this record clearly reflects that the here- claimed free moisture content range of clay in the appealed claim 1 composition is the consequence of a drying step and thus is presumably less than the free moisture content of the clay used in Brooks' composition (i.e., because patentee does not teach subjecting his clay to a drying step).

Under the foregoing circumstances, we are constrained to regard the examiner as having failed to carry her initial burden of establishing a **prima facie** case of obviousness with respect to independent composition claim 1 and claims 2-15 which depend therefrom.

As for independent article claim 16, the appellants argue that the applied prior art contains no teaching or suggestion of a composition package which is provided with a vapor barrier as required by this claim. According to the examiner, "it would have been obvious to package a material **which must maintain a low moisture content** by putting it in a suitable package" (answer, pages 5-6; emphasis added). The fatal deficiency of this obviousness conclusion is the examiner's failure to provide any reference teaching or suggestion concerning a prior art material "which must maintain a low moisture content." It is only the appellants' own disclosure which teaches the desirability of and reasons for maintaining a low moisture content. Therefore, the examiner also has failed to establish a **prima facie** case of obviousness with respect to the claim 16 feature under consideration.

Finally, the appellants argue that appealed independent claim 17 requires the sorptive purification method defined therein to occur prior to bleaching whereas the composition of Brooks is taught for use exclusively in a method for bleaching oils. In responding to this argument, the examiner states that "no patentable distinction is seen as the method is almost the same" (answer, page 6). From our perspective, this statement by the examiner constitutes an implicit acknowledgment that the

respective methods claimed by the appellants and disclosed by Brooks are not the same and thus, in fact, are different. Yet, the examiner has not even proposed a modification to the method of Brooks which would eliminate this difference. As a consequence, we must conclude that yet again the examiner has failed to carry her burden of establishing a ***prima facie*** case of obviousness with respect to independent method claim 17 and claims 18-20 which depend therefrom.

For the reasons set forth above, we cannot sustain the examiner's § 103 rejection of appealed claims 1-20 as being unpatentable over Brooks in view of Audeh.

The decision of the examiner is reversed.

Appeal No. 1998-1306
Application 08/429,326

REVERSED

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| | ROMULO H. DELMENDO |) | |
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BRG:psb

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